

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**  
**P.O. Box 1451**  
**Alexandria, VA 22313-1451**

Mailed: December 2, 2004

Concurrent Use No. 94002078

I MATTI RISTORANTE, INC.

v.

CAMPO DE FIORI, L.L.C.

Cindy B. Greenbaum, Attorney:

The parties have submitted a settlement agreement for the Board's approval. The settlement agreement provides for the issuance of a concurrent use registration to applicant geographically restricted to the Regions of the United States located in: (a) the Mountain, Pacific, Alaska, Hawaii-Aleutian, and Samoa standard time zones; (b) the State of Texas; and (c) the State of Illinois, except as provided in a "sub-licensing" provision in the settlement agreement. The settlement agreement further provides for the amendment of registrant's registration to geographically restrict it to the Regions of the United States located in: (a) the Atlantic standard time zone; (b) the Eastern standard time zone, including the State of Florida, except as provided in a "sub-licensing" provision in the settlement agreement; and (c) the Central standard time zone, except

(i) the State of Texas, and (ii) the State of Illinois, except as provided in a "sub-licensing" provision within the settlement agreement.<sup>1</sup>

With regard to the "sub-licensing" provisions, the settlement agreement provides that registrant will grant applicant a "sub-license" to use the mark in Florida, while reserving registrant's right to use the mark within that state. Similarly, the settlement agreement provides that applicant will grant registrant a "sub-license" to use the mark in Illinois, while reserving applicant's right to use the mark within that state.

The "sub-licensing" terms of the agreement do not appear to support a finding of no likelihood of confusion because, for example, the wording in paragraphs 3 and 4 permits each party to use the mark under "sub-license" from the other party in states which otherwise fall in the other party's geographic territory. In other words, this is not a licensing agreement, but rather registrant's consent to applicant's use of the mark in registrant's territory, and applicant's consent to registrant's use of the mark in applicant's territory. The use of identical marks for identical services within certain states envisioned by the licensing provisions likely would not avoid confusion.

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<sup>1</sup> The Board interprets the agreement as providing for the geographic restriction of Registration No. 2348945.

In addition, although the agreement includes quality control provisions relating to the products produced and services rendered by each party, and the advertising and promotional materials bearing the mark for the purpose of ascertaining or determining compliance with those quality provisions, the agreement is silent on the actions the parties intend to take to prevent likelihood of confusion among consumers, including the restriction of each party's advertising to its own geographic territories.

The parties are allowed until THIRTY DAYS from the mailing date of this order to file a settlement agreement that addresses the above-noted deficiencies.

This proceeding is otherwise suspended.